UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/832,141	04/09/2001	John W. Chrisman III	4826US	8520

7590 06/17/2009

BRICK G. POWER
TRASK, BRITT & ROSSA LAW OFFICES
P.O. BOX 2550
SALT LAKE CITY, UT 84110

EXAMINER	
PIERCE, WILLIAM M	
ART UNIT	**PAPER NUMBER**
3711	

MAIL DATE	DELIVERY MODE
06/17/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

RECORD OF ORAL HEARING

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex Parte JOHN W. CHRISMAN III.

Appeal 2009-001028
Application 09/832,141
Technology Center 3700

Oral Hearing Held: May 21, 2009

Before DEMETRA J. MILLS, LORA M. GREEN and JEFFREY N. FREDMAN, *Administrative Patent Judges.*

APPEARANCES:

ON BEHALF OF THE APPELLANT:

H. Dickson Burton, Esquire
TRASK, BRITT & ROSSA LAW OFFICES
P.O. Box 2550
Salt Lake City, Utah 84110

PROCEEDINGS

MS. BEAN: Good afternoon. Calendar No. 62. Mr. Burton.

JUDGE MILLS: Thank you.

MS. BEAN: You're welcome.

MR. BURTON: Good morning.

JUDGE MILLS: Feel free to get set up, and of course, you have --

MR. BURTON: Thank you very much.

JUDGE MILLS: -- 20 minutes, and you can begin whenever you're ready. And if you wouldn't mind --

MR. BURTON: Thank you.

JUDGE MILLS: -- providing the court reporter with a business card.

MR. BURTON: Certainly.

Your Honors, I'm -- I suppose I'm ready to go forward.

JUDGE MILLS: Okay, good.

MR. BURTON: First of all, thank you this afternoon. My name is Dickson Burton. My partner Brick Power has been primarily the prosecuting attorney on this, on this case, and I'm pleased to be here.

Your Honors, this is a case essentially where we would assert the Examiner has I suppose been stubborn in not, in not recognizing the, the unusually unexpected success of this invention that was, that was not predictable, that was not anticipated but is instead relying on references that do provide some of the building blocks for this invention undoubtedly but again would not lead one toward -- of ordinary skill in the art to the

conclusions or to anticipate I should say the, the success that has been experienced. KSR in fact states that the Supreme Court states that inventions usually rely upon building blocks long since uncovered, and claimed discoveries almost necessarily will be combinations of what in some sense is already known. The Court goes on to explain that the inquiry should be does it lead, do those pre-existing building blocks lead to anticipated, predictable success. And particularly with respect to the claims in our case that go to the bowling ball, we would submit that in fact those of ordinary skill in the art were led away from using these building blocks which is adding the fragrance to the resins in manufacturing the bowling ball.

JUDGE FREDMAN: What would you state is the level of skill in the art?

MR. BURTON: Your Honor, the Examiner seems to want to say that it's a bowler. We would respectfully disagree. We think it is a manufacturer of bowling balls. It's one who is -- has knowledge of putting the building blocks, as it were, together to make the bowling ball. It's not one that is just skilled at rolling the ball down the lane. Okay.

JUDGE MILLS: Do you have an issue with the Examiner's prima facie case, or are you relying solely on your unexpected results?

MR. BURTON: We do have an issue with the prima facie case as well, Your Honor, and the Examiner is relying on two references. The final rejection cites Shibanai, if I pronounce that correctly, and Coffey (phonetic sp.), neither of which discloses use of a fragrance with a two-part resin.

Your Honor, those references I think are distinctly different from what we're talking about here. Shibanai talks about adding a fragrance into a cyclodextrin, the fragment of a starch. That compound is then dried, ground up and crushed into a powder. Then it is mixed with a resin, and that disclosure talks about thermoplastic or thermo-set resins. It's formed into pellets or further just used in the powder in a malt. Typically, all of the examples I believe talk about forming these pellets of this cyclodextrin compound with the resin. All of that seems to be concerned with dealing with the heat that is later applied in forming and curing the resins.

Coffey is similar and yet also quite different on its own. There we're talking about natural fragrances in botanical material. We're talking about bits of flowers or pods, and that natural botanical material is bound by what the patent disclosure describes as a minor amount of a fluorocarbon resin, a fluorocarbon resin binder such as Teflon, and then it is baked by heating it to the curing temperature of that resin. So again we're talking about a one-part resin process, thermoplastic in that case, and again quite different. Those references are simply not going to lead someone to the type of article of manufacture that is a bowling ball. It has a very different purpose that is used -- that is manufactured with a two-part resin process.

And here we have the bowling industry, and this is made reference to in Mr. Chrisman's, one of his declarations. I believe it's the March 29, '06 declaration where he talks about how bowling manufacturers are extremely reluctant to add anything into their product that might impact performance. Now as we know these fragrances, and they're often oils, are going to

eventually leach out to the surface. And so there would be great reluctance to add something like a fragrance to the, the bowling ball. And again, neither of the references that the Examiner relies upon tell us anything differently from that.

And so again I -- we do have the problem with the prima facie case. But getting past that prima facie case, the Examiner again did not want to accept the overwhelming commercial success. Now he has some criticisms in, in some of his rejections of the evidence that was put forward saying we don't know that -- what it's attributable to, and a great PR firm might have gotten all this media. But Mr. Chrisman responded again in his March '06 declaration very plainly stating --

JUDGE MILLS: Could we back up just real --

MR. BURTON: Excuse me?

JUDGE MILLS: Could we back up just real quickly before we go into the commercial success evidence?

MR. BURTON: Certainly.

JUDGE MILLS: The Examiner seemed to have an issue regarding the prima facie case with the definition of your two-part resin and seem to believe that epoxy resins read on your definition and specification. Do you -- could you address that for a moment?

MR. BURTON: Certainly, Your Honor. The Shibanai reference where it mentions the epoxy resin talks about, if I can get it in front of me, this is column 7, lines 54 to about 60 of that reference. It's talking about a synthetic resin coating first of all, and then it gives an example of synthetic

resin coatings are alkaloid resin coatings and so forth and, and lists epoxy resin coatings.

So first of all, it's unclear when it's talking about a coating whether it's talking about even the, the substance into which the fragrance is added. I don't think that's clear from this reference at all. Secondly, there are different types of epoxies, and within this reference, it is, it is talking about the combination with the cyclodextrin and, and the creation of the glycitol which forms a covering over, over this -- these pellets to help the fragrance withstand the heat. So again, we're not talking about a two-part resin where there's simply a catalyst, and after the addition of the catalyst you get a cure without adding any other heat. And so again, a person of skill in the art looking at that reference is not going to see epoxy resins as the two-part resin that is contemplated in Mr. Chrisman's application.

JUDGE MILLS: Could you direct me to where in the specification it defines your two-part resins?

MR. BURTON: I'm sorry?

JUDGE MILLS: Can you direct me to where in the specification that you have defined your two-part resins?

MR. BURTON: Oh, okay, in our application.

JUDGE MILLS: Yeah.

MR. BURTON: Well, Your Honor, in -- we have not defined the term two-part resin, conceded. However, the, the first several pages --

JUDGE FREDMAN: Would you, would you concede that two-part resins were well known in bowling ball making?

MR. BURTON: Yes, we would concede that.

JUDGE FREDMAN: Okay. So I mean so it's more than I think the secondary considerations that should drive this it sounds like. I would like to have you discuss something that you put in your -- I guess it's a piece of evidence you added to the declaration, the article by Jonathan Eig in -- I can't tell where it's from here. It must have been a newspaper though, because you have some statements in it that I think are interesting where he says but to nearly everyone's surprise, including plenty of bowlers -- when they got their first whiff, Storm's scented balls are quite popular between the pro-shop owners and others in the business, and they have turned the little company into one of the hottest players in an otherwise down-at-the-heels industry. I wonder if you could discuss maybe more of this for secondary considerations with regard to some of these articles.

MR. BURTON: Certainly. Your Honor, it was a phenomenon that was not expected by Storm Products, which is the company owning the application, the, the publicity that kind of took on a life of its own. And as Mr. Chrisman states in his declaration, it was not solicited. They did not have a PR firm. They did not have an in-house PR person.

JUDGE FREDMAN: Where does he say that? I'm not --

MR. BURTON: That was in the March 29 declaration that was submitted --

JUDGE FREDMAN: March 29 of what year?

MR. BURTON: -- in connection with the original Appeal Brief, and paragraph 5, Your Honor.

JUDGE FREDMAN: March 29 of what year?

MR. BURTON: '06, I'm sorry.

JUDGE FREDMAN: Well, keep going.

MR. BURTON: Okay.

JUDGE FREDMAN: I'll find it or not.

MR. BURTON: Okay, well, I'll read from it. It says "The positive press received by Storm in connection with its scented bowling ball indicating that which is referenced in my June 24, 2005 declaration," and that's the one I believe that enclosed not only articles but a DVD or a CD with video on it from the "Today" show and a number of other national and local television broadcasts.

JUDGE FREDMAN: Right.

MR. BURTON: He goes on to say "has not been solicited by Storm. Storm does not have a public relations expert or firm and did not retain one to generate any of the press which has been received by Storm for its scented bowling ball. Neither Storm nor any representative of Storm solicited the newspaper, television and other media reports and accounts including those referenced in my prior declaration."

He goes on to respond to the Examiner's concern that the increased sales are a result of advertising dollars, and he says that -- very clearly in paragraph 6 of that same declaration that the advertising increases that it was able to afford because of increased sales followed the upward trend in the sales. It -- he says while Storm has gradually increased its overall expenditures in marketing since 2001, which is a year after it introduced the

scented bowling ball, the increases have followed the surprising success of the scented bowling ball. They have not preceded that success. It is clear from our sales and marketing expenditures history that Storm has only been able to increase expenditures because it first had increased sales revenue from the scented bowling ball.

Now in his other declaration, he explained how bowling balls in the same market segment are lower priced than the scented bowling ball. It is a clear mark of success. It has allowed Storm to increase its market share dramatically, and that can only be attributed to the, to the fantastic success of this invention. It, it seems to be overwhelming evidence of commercial success.

Now recognizing again that the building blocks for this invention were in place, but again, as, as KSR talk about, the next question is do those building blocks lead to a predicted level of success, to anticipated success, and again, in the context of a bowling ball and talking particularly about the bowling ball claims that we have in our claims set, it was absolutely not expected, and in fact, the opposite would have been expected.

And so Your Honors, it's a simple case. Right now I don't have anything else to argue. If there are other questions, I'll address them, but that is our presentation, and we would urge your consideration of our position.

JUDGE MILLS: Okay, I don't have any further questions. No, okay.

MR. BURTON: Thank you very much.

JUDGE MILLS: Okay, thank you.

JUDGE FREDMAN: Thank you.

(Whereupon, the hearing concluded at 1:29 p.m., on May 21, 2009.)